

REMARKS

Claims 21-30 are pending in this application. Claim 21 has been amended without acquiescence and without prejudice to clearly define the scope of the invention. Support for the amendment can be found throughout the specification, more specifically, on page 4, lines 27-30, page 6, lines 8-9, and pages 11-12. Claims 28 and 29 have been amended to correct the dependency.

This issues outstanding are as follows:

- The Specification has been objected to as allegedly containing informalities.
- Claims 28 and 29 have been rejected by the Examiner under 35 U.S.C. 112, second paragraph, as allegedly being indefinite.
- Claims 21-27 have been rejected by the Examiner under 35 U.S.C. 102(b) as being allegedly anticipated by Richar, US Patent 5,405,836.
- Claims 21-28 have been rejected by the Examiner under 35 U.S.C. 102(b) as being allegedly anticipated Paluch., US Patent 6,117,477
- Claims 21-27 been rejected by the Examiner under 35 U.S.C. 102(b) as being allegedly anticipated by Baasiouny et al. (Food Chem., 37(4):297-305, 1990).
- Claims 21-27 been rejected by the Examiner under 35 U.S.C. 102(b) as being allegedly anticipated by Fuller, US Patent 4,294,857.
- Claims 21-30 have been rejected by the Examiner under 35 U.S.C. 103(a) as being allegedly unpatentable over Aga et al., US Patent 5,922,324.
- Claims 21-30 have been rejected by the Examiner under 35 U.S.C. 103(a) as being allegedly unpatentable over Scaglione et al., US Patent 5,000,973 in view of Nabi et al., US Patent 5,472,684.

- Claims 21-30 have been rejected by the Examiner under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 21-30 of US Patent No. 6,495,176.
- Claims 21-30 have been rejected by the Examiner under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 21-30 of US Patent No. 6,652,892.

Applicants respectfully traverse the outstanding rejections and objections, and Applicants respectfully request reconsideration and withdrawal thereof in light of the amendments and remarks contained herein.

I. Objection of Specification

The Specification is objected to because informalities indicating the date of Application No. 10/238,788. Applicants have amended the specification to reflect the correct date. Applicants request withdrawal of the objection.

II. 35 U.S.C. §112, second paragraph

Claims 28 and 29 are rejected under 35 U.S.C. 112, second paragraph as being indefinite. Applicants traverse.

In order to further the prosecution of this application, Applicants have amended the dependency of claims 28 and 29. In light of this amendment, Applicants request that the rejection be withdrawn.

III. 35 U.S.C. §102(b)

A. Richar US Patent 5,405,836

Claims 21-27 are rejected by the Examiner under 35 U.S.C. 102(b) as being anticipated by Richar US Patent 5,405,836. Applicants respectfully traverse this rejection and request reconsideration and withdrawal thereof in light of the following remarks.

Anticipation of a claim is only established where “each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.”

Verdegel Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed.Cir. 1987).

Richar does teach chlorophyll extracts. However, Applicants assert that chlorophyll extracts does not fall within the scope of the pending claims, where the plant extract is essential oils, oleoresins, absolutes, and fruit juices.

Chlorophyll is a magnesium complex of a substituted porphyrin ring which is generally extracted from plants using acetone or a blend of hexane/acetone. Chlorophyll is colorant and is used as a dye or pigment. A copy of an extract from the Merck Index (12th Edition) on chlorophyll is enclosed herewith. Clearly, chlorophyll is not an essential oil, oleoresin, absolute, or fruit juices, the definitions of which are set out on pages 5 and 6 of the present specification.

In view of the above, Applicants respectfully request that the rejection be withdrawn.

B. Paluch US Patent 6,117,477

Claims 21-27 are rejected by the Examiner under 35 U.S.C. 102(b) as being anticipated by Paluch US Patent 6,117,477. Applicants respectfully traverse this rejection and request reconsideration and withdrawal thereof in light of the following remarks.

Anticipation of a claim is only established where “each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegel Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed.Cir. 1987).

Paluch teaches a dual component pet food having an inner component that is surrounded by an outer component. More specifically, Paluch teaches that the ingredients that may be used to improve oral malodor are added to the inner component or center filling material, which is a lipid based composition (See Column 5, lines 56-67 and Column 6, lines 1-20 and lines 45-53). The outer component of Paluch is more similar to the dough based composition of the present invention, and this component does not contain the ingredients to improve oral malodor. Thus, Paluch does not teach each limitation of the pending claims. In light of this argument, Applicants request that the rejection be withdrawn.

C. Baasiouny et al.

Claims 21-27 are rejected by the Examiner under 35 U.S.C. 102(b) as being anticipated by Baasiouny et al. Applicants respectfully traverse this rejection and request reconsideration and withdrawal thereof in light of the following remarks.

Anticipation of a claim is only established where “each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegel Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed.Cir. 1987).

In order to advance prosecution of the present invention, Applicants have amended independent claim 21 without prejudice and without acquiescence to clarify the scope of the invention. The functional limitation “whereby said composition reduces malodour in a pet.” Applicants assert that this limitation provides patentable weight which should be considered by the Examiner. See e.g., *In re Ludtke*, 444 F.2d 660, 169 USPQ 563, 566 (CCPA 1971); *In re Swinehart*, 439 F.2d 210, 169 USPQ 226, 228-29 (CCPA. 1971); and *In re Barr*, 444 F.2d 588, 170 USPQ 33 (CCPA 1971).

The soda cracker of Bassiouny et al. describes a dough in which either plant extracts or purified ether extracts were added to the dough to produce a soda cracker having increased stability, for example addition of the plant materials to function as antioxidants, thereby protecting the cracker from oxidation (See abstract and introduction on page 297).

Thus, in view of the newly amended claim 1, Applicants assert that the Bassiouny et al. does not contain all the limitations of claim 1 and thus the rejection should be withdrawn.

D. Fuller et al., US Patent 4,294,857

Claims 21-27 are rejected by the Examiner under 35 U.S.C. 102(b) as being anticipated by Fuller et al., US Patent 4,294,857. Applicants respectfully traverse this rejection and request reconsideration and withdrawal thereof in light of the following remarks.

Anticipation of a claim is only established where “each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.”

Verdegel Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed.Cir. 1987).

In order to advance prosecution of the present invention, Applicants have amended independent claim 21 without acquiescence and without prejudice to clarify the scope of the present invention. More particularly, claim 21 is amended to clarify that the dough is mixed with a plant extract, which is the opposite of the pet food taught in Fuller. The pet food composition of Fuller is a pet food in which the palatability enhancing amount of linalool is coated on the surface of the food. See, col. 4 line 43-44, col. 5. lines 5-7, col. 5. line 30, etc. Thus, in view of the present amendment, Applicants assert that Fuller does not teach all the limitations of claim 21 and respectfully request that the rejection be withdrawn.

IV. 35 U.S.C. §103(a)

A. Aga et al., US Patent 5,922,324

Claims 21-30 have been rejected by the Examiner under 35 U.S.C. 103(a) as being allegedly unpatentable over Aga et al., US Patent 5,922,324. Applicants respectfully traverse this rejection and request reconsideration and withdrawal thereof in light of the following remarks.

As established by *In re Royka*, *prima facie* obviousness of a claimed invention can only be established if all the claim limitations are taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). The Examiner has failed to show that all the claimed limitations are taught or suggested by the cited references. Aga teaches that propolis is a resin-like product that is stored by bees in beehives. Applicants assert that a composition containing propolis, a compound found in beehives, does not teach nor suggest a composition containing plant extracts. Applicants also assert that Aga does not suggest that propolis can be substituted for a plant extract. Thus, one of skill in the art would not have been motivated to substitute a plant extract for propolis.

Yet further, Aga teaches that propolis extracts can be used in combination with a laundry list of compositions. Once such composition is a food product, such as pet food or animal feed. Applicants respectfully assert that the broad laundry list of “compositions” in column 4 and 5 disclosed in the Aga reference does not enable one of skill in the art to

produce the breath-freshening pet food of the present invention. In fact, if anything, the Aga reference teaches that propolis can be added to formula feed to prevent diseases and diarrhea of domestic animals, promote appetite and growth and prevent unsatisfactory smell of their feces. See column 12, lines 37-57. Aga does not teach nor suggest that the propolis can be used to improve oral malodour in domestic animals.

Regarding the Examiners reference to the specification, Applicants remind the Examiner that the courts have required that an Examiner must show some suggestion or motivation, excluding the invention itself, to make the new combination. See *In re Rouffet*, 149 F.3d 1350, 1355-56 (Fed. Cir. 1998); *In re Lee* 277 F. 2d 1338, 61 USPQ 2d 1430 (Fed. Cir. 2002); and c.f. *Ruiz v. A.B. Chance Co.*, F.3d 1270 (Fed. Cir. 2004).

Thus, with the lack of teaching or suggestion to produce a breath-freshening pet food containing a plant extract, Applicants assert that the Aga reference does not meet the basic requirements of a *prima facie* case of obvious.

B. Scaglione US Patent No. 5,000,973 in view of Nabi US Patent 5,472,684

Claims 21-30 have been rejected by the Examiner under 35 U.S.C. 103(a) as being allegedly unpatentable over Scaglione et al., US Patent No. 5,000,973, in view of CFR, title 21, Part 101, Subpart B, Sec. 101.22, in further view of Nabi et al., US Patent 5,472,684. Applicants respectfully traverse this rejection and request reconsideration and withdrawal thereof in light of the following remarks.

Applicants assert that the Examiner has not established a *prima facie* case of obviousness to reject the claims under 35 U.S.C. 103(a). *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438, (Fed. Cir. 1991). A *prima facie* case necessitates disclosure of the source for either a suggestion or motivation to modify this reference to produce the present invention, and a reasonable expectation of success of producing the present invention.

Scaglione teaches a dog biscuit comprising phyrophosphate. Table 2 and Table 4 of Scaglione does mention that the biscuit can contain natural flavorants, however, it is not taught what these flavorants are or the purpose have adding the flavorants. Thus, one of art would assume that the natural flavorants are merely added for the purpose of flavoring, not for reducing malodor. The Examiner has combined CFR Title 21 with Scaglione to indicate a

list of natural flavorants. Once again, Applicants assert that CFR Title 21 does not correct the defects of Scaglione in that CFR Title 21 does not teach or suggest that the natural flavorants are added to reduce malodor nor does CFR Title 21 indicate with natural flavorants could be used to reduce oral malodor, thus the combination of Scaglione and CFR Title 21 does not teach or suggest all the limitations of the present invention. Still further, the Examiner has added Nabia because Nabia teaches mouth washes/rinses, toothpaste, or gum having tea tree oil and eucalyptus to enhance antiplaque and antigingivitis activity, however, Nabia does not teach or suggest a breath-freshening pet food composition which reduces malodor in a pet.

In view of the above arguments, Applicants assert that the combination of Scaglione, CFR Title 21 and Nabia does not teach all the claim limitations of the present invention, thus as Applicants respectfully request withdrawal of the rejection.

V. Double Patenting

A. US Patent 6,495,176

Claims 21-30 are rejected by the Examiner under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 21-30 of US Patent No. 6,495,176. Applicants traverse.

Applicants note that the '176 patent has an apparent patent term through July 17, 2018. A patent issuing from the present application would normally expire on July 17, 2018. Therefore, applicants expect no loss in patent term as a result of filing a terminal disclaimer in the present application. Without agreeing to the substance of the Examiner's rejection and in the interest of expediting the prosecution, Applicants submit herewith a terminal disclaimer over the '176 patent.

B. US Patent 6,652,892

Claims 21-30 are rejected by the Examiner under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 21-30 of US Patent No. 6,652,892. Applicants traverse.

Applicants note that the '892 patent has an apparent patent term through July 17, 2018. A patent issuing from the present application would normally expire on July 17, 2018.

Therefore, applicants expect no loss in patent term as a result of filing a terminal disclaimer in the present application. Without agreeing to the substance of the Examiner's rejection and in the interest of expediting the prosecution, Applicants submit herewith a terminal disclaimer over the '892 patent.

CONCLUSION

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 06-2375, under Order No. 10311777 from which the undersigned is authorized to draw.

Dated: September 7, 2004

Respectfully submitted,

By 

Melissa W. Acosta

Registration No.: 45,872

FULBRIGHT & JAWORSKI L.L.P.

1301 McKinney, Suite 5100

Houston, Texas 77010-3095

(713) 651-5151

(713) 651-5246 (Fax)